

Applicants : Nigel Paul Maynard *et al.*
Serial No. : 10/580,160
Filed : May 19, 2006
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Attorney Docket No.: 65501-003US1
Client Ref. No.: SHR 504620USPR

REMARKS

The present document is submitted in reply to the Office Action dated June 17, 2010 (“Office Action”).

Applicants have amended claims 1, 22, and 23 to more particularly point out the subject matter that they deem as their invention. More specifically, the limitation “boil or evaporate” recited in these claims has been narrowed to “boil”. Support for the limitation “boil” can be found in the Specification at page 6, lines 12-15. Applicants have also amended claim 1 to promote clarity. No new matter has been added by the amendments. Note that claims 4, 8, 13, and 24-30 were cancelled previously.

Claims 1-3, 5-7, 9-12, 14-18, and 22 are currently pending and under examination. Applicants respectfully request that the Examiner reconsider this application in view of the following remarks.

Rejection under 35 U.S.C. § 102

Claims 1-3, 5-7, 9-12, 14-18, and 22 were rejected as being anticipated by US Patent 5,555,642 to Rem et al. (“Rem”). See the Office Action, page 2, item 2.

Claim 1 as amended will be discussed first. This claim is drawn to a method for conditioning a substrate. The method includes a step of releasing pressure from a constrained environment such that moisture in the substrate **boils**.

The method of claim 1 can be used to condition a wood substrate so that it can be subsequently or concurrently treated with desired compositions (e.g., preservatives). The step in which moisture in the substrate **boils** is critical to the method. The boiling, which forces moisture out of the wood substrate, ejects cellular debris and thereby creates voids that facilitate treatment of the substrate with desired compositions. See the Specification at page 6, lines 11-18.

Rem teaches a method for softening wood by heating it in an autoclave, i.e., a constrained environment. See column 6, lines 1-9. This reference further teaches that controlled and gradual depressurizing of the autoclave to atmospheric conditions causes moisture in the wood to partially **evaporate**. *Id.*

It is common knowledge that **boiling** and **evaporation** are two different processes. Indeed, a skilled artisan would have readily recognized that the method described in Rem does not cause release of pressure from a constrained environment such that moisture in the substrate **boils**, as required by amended claim 1.

It follows that, as Rem does not teach a step requiring **boiling** of moisture, this reference does not anticipate claim 1. Nor does it anticipate claims 2, 3, 5-7, 9-12, and 14-21, each directly or indirectly dependent from claim 1.

Turning to independent claim 22, this method claim, like claim 1, also requires a step in which moisture within a substrate **boils**. For the same reason set forth above, claim 22 is novel over Rem.

Rejection under 35 U.S.C. § 103

Claims 19-21 were rejected for obviousness over Rem in view of Neogi et al., US Patent Application Publication 20040258941 (“Neogi”). See the Office Action, page 2, item 4. Claim 19, dependent from claim 1, will be discussed first.

Claim 19 covers a method for conditioning a substrate. The method includes a step in which moisture in the substrate boils, as well as a step in which the substrate is impregnated with a composition.

As mentioned above, Rem teaches a method for softening wood, in part, by partially evaporating moisture in the wood. Nowhere in Rem is taught or suggested boiling the moisture, as required by claim 19.

Neogi, the other reference cited by the Examiner, does not cure this deficiency. Indeed, as pointed out by the Examiner, Neogi merely teaches a substrate impregnated with a composition. See the Office Action, page 3, first paragraph. As Neogi does not teach or suggest boiling moisture in the substrate, it does not rectify the just-mentioned deficiency of Rem.

In view of the remarks above, Applicants submit that the Examiner errs in concluding claim 19 would have been obvious over Rem in view of Neogi. For the same reasons, claims 20 and 21, both dependent from claim 19, are also nonobvious over the cited references.

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For a complete record, Applicants point out that claim 23 was omitted from the text of the rejections set forth in the Office Action. Amended method claim 23, like claims 19-21, requires a boiling step. Applicants submit that this claim is novel over Rem and nonobvious in view of Rem and Neogi for the same reasons set forth above.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment.

In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Petition for Extension of Time fee in the amount of \$245.00 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 65501-003US1.

Respectfully submitted,

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